

REMARKS

I. Summary of the Office Action

Claims 1-113 were pending in this case.

Claims 1-7, 9-13, 15, 16, 18-36, 38-43, 45-51, 53-57, 59-60, 62-72, 74-84, 86-90, 92-93, 95-98, 100-102, 104-109 and 111-112 were rejected under 35 U.S.C. 103(a) as being obvious from Graves et al. U.S. Patent No. 5,410,344 (hereinafter "Graves") in view of Roth U.S. Patent No. 6,583,797 (hereinafter "Roth").

Claims 8, 14, 17, 37, 44, 52, 58, 61, 73, 85, 91, 94, 99, 103, 110 and 113 are rejected under 35 U.S.C. 103(a) as being obvious from Graves in view of Roth.

II. Summary of Applicants' Reply

Applicants have amended claims 1, 23, 30, 36, 43, 67, 78, and 104 to more particularly define the claimed invention. Applicants have cancelled claims 5, 25, 38, 49, 70, 82, 107 without prejudice and have amended claims 6, 26, 71, 83, and 108 to update the dependency. No new matter has been added and the claim amendments are fully supported by the originally-filed application. See, e.g., applicants' specification at page 19, lines 14-30 and FIG. 3.

Applicants respectfully traverse the Examiner's rejections.

III. Applicants' Response to the § 103 Rejections

A. Independent Claims 1, 23, 30, 36, 43, 67, 78, and 104

Applicants' invention, as defined by independent claims 1, 23, 30, 36, 43, 67, 78, and 104, is directed to methods and systems for which an interactive television program

guide is at least partially implemented on user equipment. A list of programming themes is displayed in which "each programming theme" is "selectable as a search criterion" for searching program listings data. For example, as described in applicants' specification, a particular theme, such as "sports" on a list of themes can be highlighted and selected "as a search criterion for searching program listings data for programming having the 'sports' theme" (page 19, lines 14-23).

Applicants submit that these claims are patentable over the combination of Graves and Roth at least because the combination of Graves and Roth does not disclose a "programming theme" that is "selectable as a search criterion" for searching program listings data.

Neither Graves nor Roth discloses anything like a "programming theme" that is "selectable as a search criterion" for searching program listings data. At best, col. 9, lines 35-42 of Graves refers to comparing a viewer's program attribute ratings (on a 1-10 scale, as shown in FIG. 5 of Graves) to predetermined coded attribute ratings in an appropriate field associated with programs in order to determine a subset of the programs. In particular, Graves refers to comparing a number supplied by a viewer (indicating the user's preference level for a program attribute) to a predetermined number associated with each program (indicating the level of the program attribute within content of the program) in a set of programs. Graves further refers to determining a subset of the set of programs based on how closely each program's attributes match the viewer's preferences. This is not the same as a "programming theme" that is "selectable as a search criterion" for searching program listings data at least because comparing attribute ratings to predetermined coded attribute ratings in an

appropriate field involves no use of a programming theme as a search criterion. Roth does not make up for this deficiency in Graves relative to the rejection at least because Roth does not discuss anything related to programming themes. Instead, Roth discusses computer program menu items on a computer and not to any sort of programming, program listings data, or any sort of television program guide system.

For the foregoing reasons, Graves and Roth, whether taken alone or in combination, fail to show or suggest all of the elements of applicants' amended independent claims 1, 23, 30, 36, 43, 67, 78, and 104.

Moreover, applicants submit that the combination of Graves and Roth is improper. The Examiner contends that it would have been obvious to a person of ordinary skill in the art to modify what the Examiner alleges to be a list of ranked programming themes, as taught by Graves, using what the Examiner alleges to be a programming theme display ranking process, as taught by Roth, in order to arrive at features recited by applicants' independent claims. In particular the Examiner contends that this modification would have been made for the purpose of providing the improvement of instructing the menu management mechanism to maintain a certain menu order within a given menu (Office Action, page 3). Applicants respectfully disagree.

One skilled in the art would not be motivated to combine the teachings of Graves with the teachings of Roth because the two references are directed to different fields. Graves refers to a television system that provides television programs that match user rated attributes. Roth, however, refers to a general purpose computer system. One skilled in the art would certainly not be motivated to combine these two

teachings, which are directed to different fields and which do not relate in any way to program themes, for the purpose of achieving applicants' claimed approach. The combination of Graves with Roth is therefore improper.

B. Independent Claims 67, and 104

Applicants' amended independent claims 67 and 104 further specify "alternating between displaying [a] first list of programming themes and [a] second list of programming themes" (where the second list is based on a selected programming theme and level of interest from the first list)*. For example, as described in applicants' specification, a first list of themes (e.g., list of themes 501 of FIG. 17) may be displayed, a second list of favorite themes (e.g., list of themes 551 of FIG. 18, only including user selected favorite themes from the first list), may also be displayed (page 19, lines 14-23), and the user may alternate between the display of the first and second lists when, for example, the user's preferences for favorite themes change (page 28, line 27 to page 29, line 32).

In addition to the reasons discussed above, applicants submit that amended independent claims 67 and 104 are patentable over Graves and Roth at least because Graves and Roth, whether taken alone or in combination, do not show or suggest "alternating between displaying" a first and second "list of programming themes." The Office Action cites FIG. 5 and

* Applicants note that in the Response to Arguments section of the Office Action, the Examiner contends that independent claims 67 and 104 failed to recite this feature. Applicants respectfully disagree and submit that this feature is explicitly recited in applicants independent claims 67 and 104.

column 6, lines 5-52 of Graves as showing this feature (Office Action, page 13). The cited portions of Graves, however, refer to modifying a list of programs by discarding a program with a lowest grade on the list when a program of a higher grade is added to the list. This is not the same as "alternating between displaying" a first and second "list of programming themes" at least because a list of programs is not the same as a list of programming themes. Moreover, once the list of programs described in Graves is modified, alternating between displaying the program list before the program with the lowest grade on the list was discarded and the program list after this program was discarded is not possible. Again, Roth does not make up for this deficiency in Graves relative to the rejection at least because there is no mention in Roth of alternating between displaying two lists of items, let alone a first list of programming themes and a second list of programming themes.

For these reasons, Graves and Roth, whether taken alone or in combination, fail to show or suggest all of the elements of applicants' amended independent claims 67 and 104.

Accordingly, the rejection of independent claims 1, 23, 30, 36, 43, 67, 78, and 104 should be withdrawn. In addition, dependent claims 2-4, 6-22, 24, 26-29, 31-42, 44-48, 50-66, 68, 69, 71-77, 79-81, 83-103, and 105-107 are allowable for at least the reason they depend from independent claims 1, 23, 30, 36, 43, 67, 78, or 104. Accordingly, the rejection of these claims should also be withdrawn.

IV. Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance.

Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

/Michael J. Chasan/

Michael J. Chasan
Registration No. 54,026
Attorney for Applicants
ROPES & GRAY LLP
Customer No. 75563
1211 Avenue of the Americas
New York, New York 10036
(212) 596-9000